

### **REMARKS**

Claims 1-10 are currently pending. Claims 1, 5, 7, 8, and 10 are amended herein. Accordingly, Claims 1-10 remain pending after entry of this amendment.

Support for the amendments herein is located throughout the application as originally filed. For example, support for the amendments to claims 1, 5, 7, 8, and 10 is found, at least, in FIGS. 4-9. No new matter has been added.

### **35 U.S.C. § 103(a)**

Claims 1, 2, 4, 5, and 7-10 are rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent 5,835,201 to Itano *et al.* (hereinafter "Itano") in combination with U.S. Patent 6,714,324 to Kurosawa *et al.* (hereinafter "Kurosawa '324").

Independent claims 1, 5, 7, and 10 are currently amended to clarify that the film holder is adapted to be put on an original bed of a flat bead image reader that includes "a read area corresponding to frames, the number of and length of which are half the number of and half the length of frames of one roll of a strip film." A *prima facie* case of obviousness cannot be formed at least because the references do not teach or suggest a such a device.

Itano discloses an "original holder" configured to allow a scanner to recognize whether an image is "vertically long" or "laterally long" and scan accordingly. See, e.g., Itano, col. 2, lines 33-37. In Itano, the entire original P can be read regardless of the orientation of the original. See id., Figs. 8(A), 8(B), and 11(A)-12(B). Moreover, as recognized at page 8 of the Office Action, Itano "does not disclose a strip film holder mechanism for holding the strip film." Indeed, Itano is completely silent regarding film strips.

Kurosawa '324 discloses a film scanner including a transport table carried by guide bars and a film holder connected to the transport table by rails. Kurosawa does not teach or suggest a film holder adapted to be put on an original bed of a flat bead image reader that includes "a read area corresponding to frames the number of and length of which are half the number of and half the length of frames of one roll of a strip film." Rather, the read

area in Kurosawa '324 is window 103, which corresponds to the entire length of a strip of film so that all frames in the openings of the holders 201a and 201b can be read.

Finally, even if Itano and Kurosawa '324 could be said *arguendo* to teach each and every element of the claimed invention, the Office Action still fails to present a cohesive finding of obviousness that rises to the "preponderance of evidence" standard set forth in the Manual of Patent Examining Procedure. MPEP § 2142, citing *In re Oetiker*, 977 F.2d 1443, 224 U.S.P.Q.2d 1443 (Fed. Cir. 1992). In essence, the Office Action, alleges that one seeking to overcome difficulties in scanning film strips on flatbed scanners would combine a flatbed scanner from Itano with a specialized scanning device of Kurosawa '324 that modifies the scanner in a manner contrary to the presently claimed invention. Such an allegation is not persuasive because both Itano and Kurosawa '324 propose completely different strategies than the claimed invention (*i.e.* enlarging the read area), thereby "teaching away" from the present invention.

Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 1, 2, 4, 5, and 7-10 under 35 U.S.C. § 103(a) as obvious over Itano in combination with Kurosawa '324.

Claims 3 and 6 are rejected under 35 U.S.C. § 103(a) as obvious over Itano in combination with Kurosawa '324 and further in view of U.S. Patent No. 7,106,480 to Huang (hereinafter "Huang").

Claims 3 and 6 depend from claims 1 and 5, respectively. As discussed above, claims 1 and 5 are currently amended to clarify that the film holder is adapted to be put on an original bed of a flat bead image reader that includes "a read area corresponding to frames the number of and length of which are half the number of and half the length of frames of one roll of a strip film." A *prima facie* case of obviousness cannot be formed at least because the references do not teach or suggest a such a device.

As discussed above, neither Itano nor Kurosawa '324 teach or suggest a film holder adapted to be put on an original bed of a flat bead image reader that includes "a read area corresponding to frames the number of and length of which are half the number of and half

the length of frames of one roll of a strip film.” Huang also fails to teach or suggest such a film holder.

Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 3 and 6 under 35 U.S.C. § 103(a) as obvious over Itano in combination with Kurosawa '324 in further view of Huang.

In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Applicants believe that no fees are required for entry and consideration of this paper. In the event that any additional fees are required for entry and consideration of this paper, Applicants hereby authorize the Director to charge such fees to Deposit Account No. 04-1105 referencing docket no. 60816(71719)

Dated: February 12, 2009

Respectfully submitted,

By: /Brian R. Landry/  
John J. Penny, Jr.  
Registration No.: 36,984  
Brian R. Landry  
Registration No.: 62,074  
EDWARDS ANGELL PALMER & DODGE LLP  
P.O. Box 55874  
Boston, Massachusetts 02205  
(617) 239-0100  
Attorneys For Applicant  
  
Customer No.: 21874